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RECORD OF ORAL HEARING
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte ANDRES SANCHEZ

Appeal 2009-003232
Application 09/407,174
Technology Center 2600

Oral Hearing Held: August 11, 2009

Before MAHSHID D. SAADAT, KARL D. EASTHOM, and ELENI MANTIS MERCADER, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

Robert W. Mueller, Esquire
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30 The above-entitled matter came on for hearing on Tuesday, August
31 11, 2009, commencing at 9:00 a.m., at the U.S. Patent and Trademark
32 Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay,
33 Notary Public.

1 MS. BOBO-ALLEN: Calendar Number 30, Appeal Number 2009-
2 3232, Mr. Mueller.

3 MR. MUELLER: Good morning.

4 JUDGES: Good morning.

5 JUDGE SAADAT: We have the file and we've reviewed the records,
6 so you can begin whenever you're ready.

7 MR. MUELLER: Thank you.

8 Okay. This invention is directed to a telephone that stores data, public
9 telephone data and private telephone data. The idea behind the phone, let's
10 say, is, you have a business and you want to -- you have a phone for the
11 entire staff. The phone may make calls to vendors, receive calls from
12 vendors or clients, maybe service personnel. All this would be considered,
13 say, public data that all people in the office would need to be able to access.
14 Those types of calls are stored in a public call memory. Alternatively,
15 perhaps the boss may have some numbers that he may call or he will be
16 called on that he does not want the employees to be privy to, perhaps
17 corporate management, perhaps the mayor, legislators, things of that nature,
18 and he would like to have that information private and password. That is the
19 idea behind the present invention.

20 The Examiner has cited a reference, Sussman, as being anticipatory,
21 and Sussman is directed, actually, to a telephone directory. The directory
22 has two memories. One memory is provided to receive a down-loaded
23 directory, a telephone directory that is described in here as a read-only
24 directory. A second memory is provided for a user. Perhaps a user may
25 have his own numbers, perhaps, frequently used numbers, which he can get

1 from that directory and put up so he'll have them ready to use, or even he
2 may insert a number that is not in that directory that he may want to use.

3 Now the difference between us and Sussman is, Sussman, again, is a
4 directory. Sussman refers to it as sort of a PDO, if you remember back, the
5 old personal digital organizer. You would meet someone on the street, you
6 would get a business card, you'd put the name into the organizer, and that
7 would be in the directory. That is the type of directory that Sussman is
8 talking about.

9 Sussman does provide -- there's some also disclosure saying that you
10 can make a call from an entry in the memory. That is making a call -- he can
11 call a stored number. Now the present invention, what we talk about is, we
12 store a called number or an incoming, data related to an incoming number.
13 And that is really the difference here.

14 JUDGE EASTHOM: What is the distinction? I'm not -- I wasn't
15 clear from your Brief what the distinction is. Are you saying you have to
16 store it first or is there some order?

17 MR. MUELLER: Sussman has to store it first.

18 JUDGE EASTHOM: And your claim doesn't store it first, is that --

19 MR. MUELLER: Well, our claim basically is saying we will store the
20 data related to an incoming call or an outgoing call. Sussman stores
21 everything first and then you can either make a call or not. He basically just
22 has that information, sort of like a little -- his own phone book.

23 JUDGE SAADAT: So the claim -- what part of the claim requires
24 that -- the difference or distinction you just described?

25 MR. MUELLER: Well, I think, in Claim 1, we say "storing telephone
26 data related to at least one of incoming and outgoing telephone calls."

1 Again, Sussman is not dealing with incoming or outgoing telephone calls.
2 He is actually just storing numbers in a memory. Now later, they may be
3 used to make a call but it is not -- there is no means in Sussman that he can
4 make a call and then store that number.

5 JUDGE SAADAT: So what you argue requires that the storage
6 occurs at the same time or close to the time an incoming or outgoing call
7 goes out. But the claim just requires that telephone data be related to an
8 incoming or outgoing call. And in Sussman, those numbers are potentially
9 outgoing calls or related to outgoing calls.

10 MR. MUELLER: Right.

11 JUDGE SAADAT: That's how, I mean, one could see that.

12 MR. MUELLER: Okay. Well, again, we see it as, you know, storing
13 it, you know -- we store it on incoming or outgoing, whereas --

14 JUDGE SAADAT: As they come in or --

15 MR. MUELLER: Another distinction there is that --

16 JUDGE EASTHOM: Counsel, I would just -- in your Reply Brief
17 you say "We agree that the pending claims at issue do not recite that a
18 system somehow captures the data on an incoming or outgoing call." So I'm
19 understanding your argument to be that you don't have to capture or make a
20 call to get this data, or are you just saying that that's not -- maybe your --

21 MR. MUELLER: I think what we are saying there is that, you know,
22 Sussman is not able to do it from an incoming or an outgoing call, whereas
23 that's what our claims are directed to.

24 JUDGE EASTHOM: Well, I think your Reply Brief says your claims
25 -- implies that your claims do not require that you capture data from an
26 incoming or outgoing call.

1 MR. MUELLER: I'm sorry, could you tell me where --

2 JUDGE EASTHOM: It's Reply Brief 3. It's the first full paragraph,
3 second sentence.

4 MR. MUELLER: I think what that refers to is that their -- our claims
5 can allow for a user to put in information. In other words, so if you make a
6 call and if it's a -- to add in some of the related information based on that
7 call that was just made that it is currently looking to store, as opposed to the
8 system simply just grabbing information and putting it in automatically. I
9 believe that's what it's referring to.

10 JUDGE EASTHOM: Okay.

11 MR. MUELLER: Another distinction we see, it's in the last
12 paragraph of Claims 1, 11, and 16, is that these public call lists and private
13 call lists are actually stored in the telephone. Sussman, again, makes no --
14 you know, he appears to show a difference between the directory and the
15 telephone and not that there was any actual storage within the telephone. He
16 refers to the telephone as a touch tone phone. And so we don't see anything
17 in there about actually putting any memory in there or if you can, how that
18 memory would have been accessed.

19 JUDGE EASTHOM: So you're saying that you think Sussman just
20 stores a directory but not the memory, is that --

21 MR. MUELLER: Well, I think they're --

22 JUDGE EASTHOM: In other words --

23 MR. MUELLER: -- separate units.

24 JUDGE EASTHOM: What's a separate unit? The directory from the
25 memory, is that what you're saying?

26 MR. MUELLER: The directory from the telephone.

1 JUDGE EASTHOM: So Figure 2 in Sussman, you're suggesting that
2 the directory memory 9 and the user directory memory 10, those aren't in
3 the phone? Is that what you're arguing?

4 MR. MUELLER: Right. Right. It actually shows -- Figure 2 shows -
5 - the dashed line here is the directory 7; and 6, if you look at the first figure,
6 shows the telephone circuitry which is outside of that. There's nothing in
7 here to say that that is stored in the phone. And that's our point, it's not
8 disclosed one way or the other, but there is no disclosure that those
9 memories are actually in the phone.

10 JUDGE EASTHOM: Oh, that's what you're -- that's your argument
11 with respect to Claim 16 and 17? That's your -- is that what you were
12 saying earlier?

13 MR. MUELLER: Well, it was the last paragraph of 1, 11, and 16,
14 which is --

15 JUDGE EASTHOM: Oh, okay.

16 JUDGE MERCADER: Where else would the directory be stored?

17 MR. MUELLER: I assume we could have had, perhaps, a computer
18 attached to a phone, a PDA which would plug into a phone. I honestly --
19 you know, I'm guessing, because, you know, Sussman doesn't give me any
20 guidance and it's -- you know, we have to look back, now we have to
21 remember, back to the technology of 1999 and what was available. But all I
22 can tell -- you know, Sussman does not say it.

23 JUDGE EASTHOM: What about the display unit and the display
24 interface and the key interface in the key unit 17, are those -- those are in the
25 same box 7, right?

26 MR. MUELLER: Yes.

1 JUDGE EASTHOM: So are you -- you're not suggesting that those
2 aren't in the phone, right?

3 MR. MUELLER: Yeah, those are -- I -- as it appears from the
4 disclosure, they are ways of entering the information into the memories.

5 JUDGE EASTHOM: So the display unit 16, you're contending that's
6 not part of the phone?

7 MR. MUELLER: Not that we're aware of from any disclosure of
8 Sussman. It appears to just display it as separate. That is the display to
9 actually see the memory entries.

10 JUDGE SAADAT: So the telephone, you read the device, not the
11 system?

12 MR. MUELLER: Right.

13 JUDGE SAADAT: So it would be unreasonable to read the claimed
14 telephone on a telephone system?

15 MR. MUELLER: I mean, I -- of course, a lot of it depends on what is
16 a telephone system, but --

17 JUDGE SAADAT: A distributed system.

18 MR. MUELLER: Right. We see it as the -- you know, the way we're
19 claiming it here, as the telephone unit. But, you know, obviously, you can --
20 probably, as need be, but --

21 JUDGE EASTHOM: I don't have any -- did you want to add --

22 MR. MUELLER: That's all.

23 JUDGE SAADAT: Do you want to summarize or any other points
24 you want to make?

25 MR. MUELLER: Again, we -- what we see as our differences are the
26 fact that Sussman stores data. It is a telephone directory. Whereas, our

1 phone, actually we store incoming and outgoing -- data related to
2 incoming/outgoing calls, whereas, Sussman just stores information and may
3 -- later may make a call.

4 JUDGE EASTHOM: Now, why isn't an outgoing call that Sussman
5 makes stored data related to the outgoing call?

6 MR. MUELLER: Well, because, as we see it, that's actually a stored
7 -- it's already -- it's a stored entry already. You've made a call from a stored
8 entry, as opposed to actually storing data related to the outgoing call. It's an
9 action of storing from the outgoing call, as opposed to having a stored
10 number and then making an outgoing call from it. We have an active storing
11 step from the outgoing call, where Sussman has already, has previously
12 stored -- it's in memory already.

13 JUDGE EASTHOM: So you're suggesting by that argument that you
14 have to make the outgoing call first and then store the data?

15 MR. MUELLER: Right. The storing at -- basically, is from the
16 outgoing call, then it stores.

17 JUDGE SAADAT: That was what we were struggling with. The
18 claim didn't specifically -- or at least we didn't see anything in the claim that
19 required --

20 MR. MUELLER: I understand.

21 JUDGE SAADAT: -- the sequence or the particular relationship that
22 you just described.

23 MR. MUELLER: Right.

24 JUDGE SAADAT: Do you have any questions or comments?

25 JUDGE EASTHOM: That was one of my main questions. It seems --

26 JUDGE SAADAT: Do you have any more questions?

1 MR. MUELLER: Thank you very much.

2 JUDGE EASTHOM: Thank you.

3 JUDGE SAADAT: Thank you.

4 (Whereupon, the hearing concluded on August 11, 2009.)